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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,555	06/05/2001	Jorge Fernandes	005641.P002X	8891

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EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/875,555

**Applicant(s)**

FERNANDES ET AL.

**Examiner**

Jamara A. Franklin

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-23 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-23 and 32-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

Acknowledgment is made of the amendment filed on 4/15/05. Claims 20-23 and 32-42 are currently pending.

### ***Claim Objections***

1. Claims 20 and 38 are objected to because of the following informalities:  
in claim 20, line 8, insert --,-- between "time" and "power"; and  
in claim 38, line 2, insert --- at the end of the sentence.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Dependent claim 22 discusses erasing the user-specific data after the sensing area detects the electromagnetic signals, however independent claim 20, from which claim 22 is dependent upon, discusses erasing the user-specific data by removing power supplied to the memory. Claim 22 is not clear as to whether both these acts take place to erase user-specific data or whether these acts occur alternatively.

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Appropriate correction or clarification is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-23 and 32-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitai (US 6,394,347) in view of Halpern (US 6,173,897) and Baentsch (US 6,264,108).

Kitai teaches an interface card and method for performing a transaction comprising:

presenting the interface card having at least one inductor (antenna coil 102) to write data to a reader device (reader/writer 122), wherein the inductor automatically detects electromagnetic signals of the reader device and, in response, the at least one inductor is activated to transfer the user-specific data to the reader device (col. 4, lines 35-50);

wherein the at least one inductor includes a first sensing area and the presenting of the interface card is by placing the first sensing area within a distance from the reader device to allow the first sensing area to detect the electromagnetic signals (col. 9, lines 37-56 and figure 9);

wherein the inductor includes a second sensing area to detect electromagnetic signals from the reader device and the method further includes placing the second sensing area within a distance from the reader device to allow the second sensing area to detect the electromagnetic signal and, in response, the at least one inductor is deactivated to stop the transferring of the user-specific data (col. 9, lines 37-56 and figure 9);

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the method wherein the interface card comprises a processor (CPU 410) to activate the inductor to transfer user-specific data for a particular transaction to the reader device, in response to the first sensing area detecting the electromagnetic signals;

the method wherein the at least one inductor includes a liquid or semi-liquid substance;

the method further including the inductor supplying power to a power storage unit on the interface card; and

the method wherein the user-specific data is selected from a plurality of user-specific data for more than one transition type and only one transaction type of user-specific data is on the interface card at a time.

The teachings of Kitai have been discussed above.

Kitai lacks the teaching of transporting user-specific data from a personal data device to the interface card.

Halpern teaches a method for performing a transaction, the method comprising:

transporting user-specific data from a personal data device to an interface card having at least one inductor to write data (col. 5, lines 50-61).

One of ordinary skill in the art would have readily recognized that allowing a user to input data into the card via a personal device would have been beneficial to the invention of Kitai for giving the user the choice of which data and how much data to store on the card. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Kitai with the aforementioned teaching of Halpern to give the user flexibility when using the card.

Katai/Halpern lacks the teaching of withdrawing the card from the reader device wherein after a period of time power supplied to the memory is removed to erase the user-specific data.

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Baentsch teaches a method for performing a transaction, the method comprising:

withdrawing the interface card from the reader device, wherein, after a period of time, power supplied to the memory unit is removed to erase the user-specific data from the interface card (col. 4, lines 39-41 and col. 5, lines 30-35).

One of ordinary skill in the art would have readily recognized that erasing data on the card would have been beneficial for protecting the data on the card from fraudulent and potentially damaging usage. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Katai/Halpern with the aforementioned teaching of Baentsch to protect the interests of the card holder.

#### ***Response to Amendment***

6. Although it had been indicated in the non-final rejection of paper no. 1204 that claims 20-23 and 32-42 contained allowable subject matter, the examiner submits that art has been cited to reject the claims which had previously been indicated as allowable. The examiner apologizes for any inconvenience on the part of the applicant.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamara A. Franklin

Examiner

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JAF

May 18, 2005



DIANE I. LEE  
PRIMARY EXAMINER